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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,782	03/26/2004	Elia Rocco Tarantino	PATINV.0005P	9658
32856 7590 09/12/2008 WEIDE & MILLER, LTD. 7251 W. LAKE MEAD BLVD. SUITE 530 LAS VEGAS, NV 89128				
EXAMINER				
DHILLON, MANJOT K				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
09/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/810,782

**Applicant(s)**

TARANTINO, ELIA ROCCO

**Examiner**

MANJOT K. DHILLON

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 16 and 17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9, 16 and 17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/14/08 has been entered.

### ***Response to Amendment***

2. This office action is in response to applicant's response filed on 7/14/08. Applicant amends claim 1, adds claims 16 and 17, and responds to rejections. Claims 1-9, and 16-17 are pending.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 6, 8-11, 15, and 17 are is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Luciano, JR. (US 2003/0232638 A1) in view of Beaulieu et al. (US 2003/0017865 A1).

Concerning claims 1, 8, 10 and 11, Luciano, JR. teaches a method of playing a game of keno at a gaming device comprising the steps of: displaying a set of keno numbers; accepting input from a player regarding one or more player selected numbers from said keno numbers; selecting a set of game numbers [0010/0052]; designating said player selected numbers with a first indicator [Fig. 4]; determining if one or more of said game numbers match one or more of said player selected numbers [0011/0052];

replacing said first indicator associated with each player selected number with a secondary indicia **[0052/0055, Fig. 5, item 154]**. Indicia can be defined as “mark, or sign”. According to that definition, Luciano, JR. teaches replacing the initial check mark with a shaded area and a check mark, therefore replacing the first indicator with secondary indicia. Furthermore, to replace the shaded check mark with any symbol is well known to one of ordinary skill in the art and considered design choice. Beaulieu et al. teaches replacing said first indicator associated with each player selected number with secondary indicia **[0088-0091 and Figs. 16-19]**. Luciano, JR. teaches said secondary indicia associated with player selected numbers which were determined to match one of said game numbers having an attribute indicating a match and said secondary indicia associated with player selected numbers which were determined not to match one of said game numbers having an attribute indicating no match, having at least two attributes for providing information regarding at least two different game states of said game **[0052/0055]**; and determining the if the outcome of said game is a winning or losing result **[0056]**. Luciano, JR. teaches said game is played as a wagering type game and including the step of accepting a wager from a player to play said game **[0040]**.

It would be obvious to replace the shaded check mark as disclosed by Luciano, JR. with any symbol as disclosed by Beaulieu et al. because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claims 6 and 15, Luciano, JR. teaches secondary indicia displayed in physical proximity to each player selected number [0055].

Concerning claim 9, Luciano, JR. teaches said steps of displaying are performed on a video display of said gaming device [0027].

Concerning claim 17, Luciano, JR. teaches including the step of indicating said selected game numbers by a second indicator [0052/0055, Fig. 5, item 154].

7. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano, JR (US 2003/0232638 A1) or Luciano, JR in view of Beaulieu et al. (US 2003/0017865 A1).

Concerning claim 12, Luciano, JR. teaches said game is the game of bingo [0004]. Luciano, JR. teaches that a bingo game is similar to a keno game. It would have been obvious to use a bingo game instead of a keno game, because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claim 16, Luciano, JR. teaches wherein the first indicator comprises highlighting of said keno numbers which comprise player selected numbers [Fig. 4]. Luciano, JR. teaches placing a check mark on the player selected numbers, to replace

the check mark with any symbol or color is well known to one of ordinary skill in the art and considered design choice.

8. Claims 2-5, 7, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano, JR (US 2003/0232638 A1) or Luciano, JR and Beaulieu et al. (US 2003/0017865 A1) in view of Bennett et al. (WO 00/32286).

Luciano, JR. discloses the game selected symbol can be animated figures **[0032]**, however, lacks disclosing the specific actions of the animated figures. The international application to Bennett et al. teaches various methods of player information delivery in a game. Concerning claims 2-5, 7, 13 and 14, Bennett et al. teaches various animated smiley characters, other than numbers, that differ from one another in appearance to indicate happiness or celebration in a game appear when player has won or a match is indicated. These characters have mannerisms that provide information to the player **[pg. 25, figures 14 –17]**. The character may also indicate unhappiness or loss by exhibiting a sour expression **[pg. 21, lines 3-4]**.

It would have been obvious to combine the keno game in the Luciano, JR. publication with the animated figures in the international application to Bennett et al, because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-9, 16 and 17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MANJOT K. DHILLON whose telephone number is (571)270-1297. The examiner can normally be reached on Mon. - Thurs., 7 AM - 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/



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Supervisory Patent Examiner, Art Unit 3714

/M. K. D./

Examiner, Art Unit 3714